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FISCHER, ANDREW J	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENOIT POL MENEZ and CAROLYNN RAE JOHNSON

Appeal 2008-1396
Application 09/745,205
Technology Center 3600

Decided: July 25, 2008

Before HUBERT C. LORIN, JENNIFER D. BAHR, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-4 and 11-12. Claims 5-10 and 13 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM.

THE INVENTION

The Appellants' claimed invention relates to direct broadcast satellite receivers that enable viewers to order pay-per-view movies. To prevent excessive spending by household members the subscriber is provided with an individual "spending limit" capability for each user profile in the household or for the whole household system. (Specification, 1:10-32.) Claim 11, reproduced below, is representative of the subject matter on appeal.

> 11. A system for controlling user spending for a user purchasing television programs, comprising:
>
> means for providing a plurality of selectively actuatable entries for user spending limits with each entry being associated with a different-length time period, in response to a first user request;
>
> means for receiving user selection of at least one of the entries and a spending limit for each selected entry;
>
> means for determining if the spending limit for a shorter time period is greater than the spending limit for a longer time period if more than one of the entries is selected, and for providing a user warning if the spending limit for the shorter time period is greater than the spending limit for the longer time period;
>
> means for tracking a second user request to purchase a television program during the time period associated with each selected entry; and
>
> means for notifying the user in response to the second user request, if purchasing the requested television program would exceed the spending limit during the time period for any selected entry.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejection:

Smith	US 5,559,871	Sep. 24, 1996
Stodghill et al.	US 5,710,901	Jan. 20, 1998
Urakoshi et al.	US 6,067,564	May 23, 2000

The following rejection is before us for review:

1. Claims 1-4 and 11-12 are rejected under 35 U.S.C. § 103(a) as unpatentable over Smith, Urakoshi, and Stodghill.

FINDINGS OF FACT

We find the following enumerated findings of fact are supported at least by a preponderance of the evidence[1]:

1. Smith is directed to a method of maintaining a running tally of charges in a telephone call and notifying the caller when a limit on charges is approached (Abstract).

2. Urakoshi is directed to a method that stores a limit total viewing charge for a specified period of time in a pay program broadcasting receiver (Abstract).

3. Stodghill is directed to a method of validating data in a data processing system (Abstract).

PRINCIPLES OF LAW

[1] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S.Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR,* 127 S.Ct. at 1739, (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." The Court also stated "[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 1740. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*

ANALYSIS

The Appellants argue that the combination made under 35 U.S.C. § 103(a) is improper because only one of the references is drawn to a television system and that the prior art is "from three distinctly different fields" (Br. 3-4). The Appellants argue that impermissible hindsight reconstruction has been used in making the combination of references used in the rejection (Br. 4). The Appellants argue that the television system of Urakoshi and the telephone system of Smith are directed to inherently different systems and that one of ordinary skill from the television art would not be motivated to look to the telephone art to solve the problem of controlling user spending for purchasing television programs. The Appellants argue that television programs are purchased "up front" while in contrast telephone call charges are not known until the call is over and that this difference between the two technologies would not lead one of ordinary skill in the art to make the combination. The Appellants put forth similar arguments that Stodghill would not be used in the combination of references because it is related to data entry systems and not television systems (Br. 6). The Appellants argue that one of ordinary skill in the art would not consider the teachings of Stodghill when addressing the problems of controlling spending for television programs. In contrast the Examiner has found that the prior art is attempting to resolve the same problem as the Applicants. The Examiner also has determined that the Stodghill reference is not related to any particular data.

We disagree with the Appellants. In *KSR* the Court maintained "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR* at 1740. In *KSR* the Court also stated "Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of the demands known to the design community or present in the marketplace....in order to determine whether there was an apparent reason to combine the known elements." *KSR* at 1740.

Here, both the Smith and Urakoshi references are directed to limiting charges made in electronic devices (FF1 and FF2). Both the Smith and Urakoshi references are attempting to monitor and limit electronic charges in which there is a monthly bill and we consider these two references to be interrelated teachings. We find the combination of monitoring charges from a telephone system with those of a cable television system to be in the purview of one of ordinary skill in the art since both references are directed to the same problem which is to limit monthly charges. Stodghill is not directed to a method of monitoring charges but it does disclose that the claimed step of verifying data was well known in data processing systems. Clearly, any electronic device handling data would want verified data to be used for accuracy and one of ordinary skill in the art would not look to only those teachings exclusively from the satellite receiver television art when looking for suitable methods to handle data. The modification of the device of Smith to be used with satellite television system disclosed by Urakoshi and with the data verification of Stodghill to have a system which monitored

and reduced billing charges is considered an obvious and predictable combination of known elements for their established functions.

For the above reasons, we sustain the rejections of claims 1, 11, and 12. The Appellants have not separately argued the rejection of claims 2-4. Accordingly, their rejection is sustained for the same reasons as above.

CONCLUSIONS OF LAW

We conclude that the Appellants have failed to show that the Examiner erred in rejecting claims 1-4 and 11-12 under 35 U.S.C. § 103(a) as unpatentable over Smith, Urakoshi, and Stodghill.

DECISON

The Examiner's rejection of claims 1-4 and 11-12 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

LV:

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